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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/544,349	04/06/2000	William C. Bornhorst	5282USA	8014

7590 06/11/2002

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EXAMINER
CORBIN, ARTHUR L

ART UNIT	PAPER NUMBER
1761	7

DATE MAILED: 06/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

TC-7

Office Action Summary

Application No.	Applicant(s)
09/544,349	BORNHORST ET AL
Examiner	**Group Art Unit**
ARTHUR L. CORBIN	1761

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 4-17-02.

~~☒ This action is FINAL.~~

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-15 & 17-41 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-15 & 17-41 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4 & 12

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-15 and 17-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,291,008. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasoning set forth in paragraph no.5, Paper no. 5.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-3, 5-10, 12-15, 17-27 and 29-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB patent 1,050,307.

Applicant is referred to the reasoning set forth in paragraph no. 7, Paper No. 5.

5. Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the British patent as applied to claims 1-3, 5-10, 12-15, 17-27 and 29-41 above, and further in view of Matz.

Applicant is referred to the reasoning set forth in paragraph no. 8, Paper No. 5.

6. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over the British patent as applied to claims 1-3, 5-10, 12-15, 17-27 and 29-41 above, and further in view of Schwab et al.

Applicant is referred to the reasoning in paragraph no. 9, Paper 5.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1-8, 10-14, 22, 25, 26, 28-31, 38 and 41 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Robie et al (WO99/41998).

Robie et al is available as a prior art reference since applicant's claims are not fully supported by parent patent 6,291,008. The claimed limitations not supported are as follows: a moisture content of "at least 18%" (claim 1, part A and claim 4); cooking at "120 to about 194°C" (claim 1, part C); "at least one" grain ingredient (claim 4); an SME value of less than

"35" (claim 6); "40%" (claim 7); the limitation of claim 9; "sodium bicarbonate" (claim 10); performing step B for "0.1 minute" (claim 13); tempering for "1 to 5... 76.6° C" (claim 15); forming piece of "2 to 8mm" (claim 17); the limitations recited in claims 20, 23, 24, 32-36, 39 and 40; and a rope diameter of "3 to 25mm" (claim 27).

9. Claims 1-8, 10-14, 22, 25, 26, 28-31, 38 and 41 are also rejected under 35 U.S.C. 102(e) as being clearly anticipated by Robie et al (6,291,008).

Applicant is referred to paragraph no. 8 above.

10. Claims 9,15, 17-21, 23, 24, 27, 32-37, 39, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Robie et al patent .

Finding the optimum moisture content (claim 9), the optimum tempering parameters (claim 15), the optimum piece size (claim 17), the optimum amount of corn in the grain (claim 23), the optimum rope diameter (claim 27), the optimum residence time for step B (claim 32), the optimum time period between steps B and C (claim 36) and the optimum dough temperature before sheeting (claim 39) would require nothing more than routine experimentation by one reasonably skilled in this art. Cutting to subdivide (claims 20and 24) is conventional in preparing cereal products. The pellet shape (claim 40) is an obvious matter of choice and is not critical. Pumping food material from one station to another (claims 34 and 35) is also conventional.

11. Applicant's arguments filed April 17, 2002 have been fully considered but they are not persuasive. Although the British patent does not specifically recite that two separate cooking steps are used therein, as applicant contends, the cooking which is disclosed on page 2 of said patent is substantially equivalent to applicant's two step cooking in which the second cooking

step is merely a continuation or extension of the first cooking step. This is especially true since there are no claimed distinctions between applicant's first and second cooking steps.

Additionally, despite applicant's contrary belief, the starting material used in the British patent is composed of free cereal grain pieces, viz. oat grains. When the oat groats are formed into a cooked cereal, bran and germ particles are visible and are thus substantially equivalent to applicant's claimed discernible grain bits.

Finally, since Matz discloses that steeping of grain prior to processing thereof is conventional, it would have been obvious to do so in the British patent in order to introduce some water into the grain and provide an improved product after cooking.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Corbin whose telephone number is 703-308-3850. The examiner can normally be reached on Tuesday-Friday from 10 am to 7:30 pm and also alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3929. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Examiner Corbin/ng
June 7, 2002

ARTHUR L. CORBIN
PRIMARY EXAMINER
6-10-02